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10/643,974	08/20/2003	Wu Mei	241786US2SRD	4968
22850	7590	10/21/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER LEE, CYNTHIA K	
			ART UNIT	PAPER NUMBER
			1795	
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			10/21/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/643,974	Applicant(s) MEI ET AL.	
	Examiner CYNTHIA LEE	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 20-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 20-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This Office Action is responsive to the amendment filed on 7/17/2008. Claims 1, 3-7 and 20-33 are pending. Applicant's arguments have been considered but are not persuasive. Claims 1, 3-7 and 20-33 are finally rejected for reasons of record.

Claims Analysis

The limitation "fuel cell" in the preamble of claim 1 was considered but has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See MPEP 2111.02.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7 and 20-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "the platinum-containing nitride particles including a platinum nitride-based nano-material" in claims 1, 6, and 7 is not supported by the disclosure as originally filed. Applicant asserts that it is supported by the non-limiting disclosure on pg

15 line 14- page 16, line 14. However, it is noted that the non-limiting disclosure as pointed out by the Applicant does not support the limitation as newly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7 and 20-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi (JP 2002-226926) in view of Tsumura (US 2002/0015878).

Yamauchi discloses a catalyst material comprising chemical compounds X, Y, and Z. X (applicant's T) comprises Ti, Zr, Al, Fe, Cr, Mo, V, and Si. Y (Applicant's A) comprises Pt, Ag, Au, Cu, Ni, Pd, Co, Cr, Mo, W, Ti, Zr. The metallic elements are treated with a gaseous phase of ammonia (NH₃) at an elevated temperature [0012]. Yamauchi discloses embodiments in which the elevated temperature range includes from ~500C to ~1500C. See Examples 1-3.

The X falls within the range between 0.0001 atom% and 70 atom% [0008] (applicant's claim 5). Should it not be disclosed with sufficient specificity, Yamauchi discloses that the function of the generated compound becomes remarkable when carrying out the addition of X of the solid more than 0.0001 atom%. However, if the addition of a metallic element X exceeds 70 atom%, it will become difficult to distribute a functional compound particle in a matrix [0008], thus clearly teaching that the atomic

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ratio of X is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Example 5 [0027, 0028] discloses a Cu-Al solution that was held at 800 C in NH₃ atmosphere in 1 atm for 2 hours. It resulted in fine particles that are homogeneously dispersed, in which includes AlN dispersed in Cu matrix. Likewise, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mix any one of X and Y compounds under the same experimental conditions as Example 5.

The Examiner notes that in the instant Specification pg. 15 lines 14-17 that nitriding is performed at a temperature of 200 C to 1000 C for 0.05 to 100 hours in a gas atmosphere containing NH₃ with a partial pressure of 0.05 atmospheres or more.

Yamauchi must necessarily possess platinum-containing nitride particles because particles of Yamauchi are prepared by the method of the claims as supported in the Specification. The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the Yamauchi.

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Yamauchi does not disclose the average diameter of the catalyst particles.

However, Tsumura teaches that in conventional electrodes, a metal belonging to the platinum group is supported on a carbon and is used as a catalyst metal. The activity of such an electrode highly depends on the surface area of the catalyst metal. It can therefore be thought that catalytic activity may be enhanced by reducing the particle diameter of the catalyst metal to increase surface area per unit weight. However, it has been reported that as the particle diameter of the catalyst metal belonging to the platinum group decreases to below the range of 2.5 to 3.5 nm, the catalytic activity of the metal per unit weight decreases due to the particle size effect (see K. Kinoshita, J. Electrochem. Soc., 137, 845 (1990)). Consequently, the catalyst metals currently used are a platinum-group metal having a mean particle diameter of about from 2.5 to 4 nm and highly dispersedly supported on carbon particles. In order for such conventional electrodes to have sufficient properties in practical use as a cathode or an anode, the amount of the platinum-group metal supported on the cathode or the anode should be as large as 0.4 mg/cm.² or higher or 0.1 mg/cm.² or higher, respectively. In contrast, the electrodes of the invention are free from the particle size effect and show high activity even when the catalyst particle diameter is 1.5 nm or lower, preferably from 0.5 to 1.5 nm [0055]. Tsumura clearly teaches that the particle diameter is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Yamauchi does not disclose a membrane electrode assembly (applicant's claim 6) or a fuel cell (applicant's claim 7) with catalytic layer as claimed by the applicants. However, Tsumura teaches a membrane electrode assembly comprising a solid polymer electrolyte film and a cathode and anode supported by collectors ([0077] and fig 2). To make an electrode, a mixture of carbon particles and cation-exchange resin was formed. The mixture was mixed in an aqueous solution of platinum [0079, 0080] (applicant's claims 6 and 7).

Although the catalyst metal may be an elemental metal belonging to the platinum group, it is preferably an alloy comprising one or more elements belonging to the platinum group. More preferably, the catalyst metal comprises platinum element and ruthenium element. Use of a catalyst metal comprising a metal element belonging to the platinum group is preferred in that this catalyst metal has high catalytic activity in electrochemical oxygen reduction reaction and hydrogen oxidation reaction. Furthermore, use of a catalyst metal comprising platinum element and ruthenium element is effective in giving an electrode which, when used in a fuel cell employing a reforming gas containing a slight amount of CO, is highly inhibited from being influenced by the CO [0026]. Furthermore, the catalyst metal preferably contains, in addition to platinum-group metals, at least one element selected from the group consisting of magnesium, aluminum, vanadium, chromium, manganese, iron, cobalt, nickel, copper, zinc, silver, and tungsten. This catalyst metal is advantageous in that the amount of a platinum-group metal used can be lowered and the catalyst metal can have satisfactory CO tolerance and high activity in oxygen reduction reaction [0027]. It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to use Yamauchi's catalyst particles in Tsumura's fuel cell because it has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie* obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Further, Yamauchi discloses that this material is a hydrogen adsorption material [0033]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Yamauchi's catalytic material in membrane electrode assemblies and fuel cells for the benefit of catalyzing hydrogen gas in the anode.

Regarding the limitation "the platinum-containing nitride particles including a platinum nitride-based nano-material", it is noted that all material possesses nano-scale material when observed on a microscopic level.

Response to Arguments

Applicant's arguments filed 7/17/2008 have been fully considered but they are not persuasive.

Applicant asserts that no platinum nitride is produced because the solid solutions are heated to a temperature insufficient to produce the compound of the metallic element Y and the vapor phase Z.

The Examiner respectfully disagrees. Yamauchi discloses that the fine particles of the compound of the metallic element X and the vapor phase element Z are

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dispersed and precipitated in the inner part or the surface of the metallic element Y, and thus reads on Applicant's formula (1). See Abstract.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cynthia Lee/
Examiner, Art Unit 1795

/PATRICK RYAN/
Supervisory Patent Examiner, Art
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